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**OFFICE OF PETITIONS**

In re Patent of Ohta et al. : DECISION  
Patent No. 7,342,014 : ON PETITIONS  
Issue Date: March 11, 2008 : UNDER 37 CFR 1.183  
Application No. 10/773,344 : AND  
Filed: February 9, 2004 : ON REQUEST FOR RECONSIDERATION  
Attorney Docket No. : OF PATENT TERM ADJUSTMENT  
13509.105007US1 :

This is a decision on the 1) Petition under 37 C.F.R. 1.183, requesting that the Office suspend the rules and consider on the merits a Request for Reconsideration of Patent Term Adjustment under 37 C.F.R. 1.705(d) filed more than two months from the date the above-referenced patent issued; and on the 2) Petition under 37 C.F.R. 1.705(d) and Request for Reconsideration of Patent Term Adjustment, both filed on February 2, 2009.

The petition under 37 CFR 1.183 is dismissed.

The request for reconsideration of patent term adjustment under 37 CFR 1.705(d) is dismissed as untimely filed.

Any request for reconsideration, whether directed to the decision on petition under 37 CFR 1.183 or to the decision on application for patent term adjustment under 37 CFR 1.705(d), must be filed within two months of the mailing date of this decision. Extensions of time under 37 CFR 1.136 are not permitted. See 37 CFR § 1.181(f).

**BACKGROUND**

On March 11, 2008, the above-identified application matured into U.S. Patent No. 7,342,014, with a revised patent term adjustment of 357 days. A request for reconsideration of the patent term

adjustment indicated in the patent was not filed within two months of the date the patent issued. Patentees now petition under 37 CFR 1.183 to (i) suspend or waive the requirement of 37 CFR 1.705(d) that a Request for Reconsideration of Patent Term Adjustment be filed within two months of the date the patent issued; and (ii) consider the enclosed Request for Reconsideration of Patent Term Adjustment. Patentees reference the decision in Wyeth v. Dudas, No. 07-1492 (D.D.C. Sept. 30, 2008) as the basis for the petition.

**PETITION UNDER 37 CFR 1.183  
TO WAIVE THE TWO-MONTH REQUIREMENT OF 37 CFR 1.705(d)**

The above-referenced patent issued on March 11, 2008. A request for reconsideration of the patent term adjustment indicated in the patent was not filed until February 2, 2009. Patentees request the Office suspend the rules and consider on the merits the Request for Reconsideration of Patent Term Adjustment under 37 C.F.R. 1.705(d) even though it was untimely filed more than two months from the date the patent issued.

The relevant regulation, 37 CFR 1.705(d), provides that:

If there is a revision to the patent term adjustment indicated in the notice of allowance, the patent will indicate the revised patent term adjustment. If the patent indicates or should have indicated a revised patent term adjustment, *any request for reconsideration of the patent term adjustment indicated in the patent must be filed within two months of the date the patent issued* and must comply with the requirements of paragraphs (b)(1) and (b)(2) of this section. Any request for reconsideration under this section that raises issues that were raised, or could have been raised, in an application for patent term adjustment under paragraph (b) of this section shall be dismissed as untimely as to those issues. (*emphasis added*).

By the express provisions of 37 CFR 1.705(d), a request for reconsideration of patent term adjustment must be filed within two months of the date the patent issued. It is undisputed that no such request for reconsideration was filed by May 11, 2008, the date two months from the date this patent issued, March 11, 2008. Rather, on February 2, 2009, over four months after the issuance of a decision in Wyeth v. Dudas on September 30, 2008,

patentees filed the instant request for waiver of the two-month requirement.

37 CFR 1.183 provides that:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

35 U.S.C. 154 requires the Office provide an applicant with one opportunity to request reconsideration of any patent term adjustment determination made by the Director and authorizes the Director to establish the procedures for requesting such reconsideration. The procedures created by the Office<sup>1</sup> include pursuant to 37 CFR 1.705(d), a two-month period for a party to file a request for reconsideration of the revised patent term adjustment indicated in the patent.

Having considered patentees' arguments, it is concluded waiver of the two-month requirement is not warranted.

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<sup>1</sup> 35 U.S.C. § 154(b)(3) provides that the USPTO shall: (1) prescribe regulations establishing procedures for the application for and determination of patent term adjustments under 35 U.S.C. § 154(b); (2) make a determination of any patent term adjustment under 35 U.S.C. § 154(b) and transmit a notice of that determination with the notice of allowance under 35 U.S.C. § 151; and (3) provide the applicant one opportunity to request reconsideration of any patent term adjustment determination. Pursuant to the mandate and authority in 35 U.S.C. § 154(b)(3), the USPTO promulgated 37 C.F.R. § 1.705, which provides that: (1) the notice of allowance will include notification of any patent term adjustment under 35 U.S.C. § 154(b) (37 C.F.R. § 1.705(a)); (2) any request for reconsideration of the patent term adjustment indicated in the notice of allowance (except as provided in 37 C.F.R. § 1.705(d)) must be by way of an application for patent term adjustment filed no later than the payment of the issue fee and accompanied by (inter alia) the fee set forth in 37 C.F.R. § 1.18(e) (37 C.F.R. § 1.705(b)); and (3) if the patent indicates or should have indicated a revised patent term adjustment, any request for reconsideration of the patent term adjustment indicated in the patent must be filed within two months of the date the patent issued.

The primary basis for requesting waiver set forth by patentee is the extraordinary situation presented by the recent decision in Wyeth v. Dudas, No. 07-1492 (D.D.C. Sept. 30, 2008).

Specifically, patentees state that in Wyeth, the U.S. District Court for the District of Columbia held that contrary to USPTO practice, a patentee is entitled to Patent Term Adjustment credit for examination delay under 37 CFR 1.702(b) in addition to any examination delay under 37 CFR 1.702(a), to the extent that the two periods of delay "do not occur on the same calendar day or days."

Patentees have not explained why they could not have filed a Request for Reconsideration of Patent Term Adjustment within two months of the date the above-referenced patent issued. Apparently, patentees' argument is that the basis for the Request for Reconsideration of Patent Term Adjustment is the Wyeth decision, which was entered more than two months after the issuance of their patent.

The fact that the decision in Wyeth may have led the Office to grant patentees' relief if patentees had timely filed a request for reconsideration does not make the situation extraordinary. Wyeth followed the procedure set forth in 37 CFR 1.705 for requesting reconsideration of the patent term adjustment determination. Then, pursuant to 35 U.S.C. 154(b)(4)(A), Wyeth timely filed a complaint in District Court seeking judicial review of the Office's decision.

Patentees chose not to challenge their revised patent term adjustment within the two-month period. Patentees' argument that they could not have filed a Request for Reconsideration of Patent Term Adjustment within two months of the date the above-referenced patent issued because the basis for the Request for Reconsideration of Patent Term Adjustment is the Wyeth decision, which was entered more than two months after the issuance of their patent, is not persuasive.

Patentees could have filed a Request for Reconsideration of Patent Term Adjustment as Wyeth did. It is acknowledged that patentees may have chosen not to file a request for reconsideration based on a conclusion that the Office's interpretation of 35 U.S.C. § 154(b)(2)(A) was correct. Nonetheless, the fact that the District Court has now issued an Opinion contrary to the Office's interpretation does not make the situation extraordinary. This is not unlike any other

situation where a patentee (or applicant) challenges a final agency decision and the decision upon judicial review could have had applicability to another patentee (or applicant) had they taken such action. In fact, many patentees may be in the same situation as patentees with respect to the Wyeth decision. In addition, given that the law only allows 180 days for both the filing of a petition and for the Office's consideration of that petition, patentees' unexplained delay in filing the petition weighs against them.

Patentees simply fail to articulate how their failure to file a request for reconsideration of patent term adjustment within two months of the issue date of the patent was due to an extraordinary situation. Patentees cannot rely on Wyeth's actions or the Wyeth decision to establish that their situation was extraordinary.

The contention that a decision is in error is a basis for a timely request for review of the decision but does not justify a delay in seeking review of such decision.

The Office has provided notice that petitions under 37 CFR 1.182 and 1.183 or requests for certificate of corrections under 35 U.S.C. 354 and 37 CFR 1.323 or 35 U.S.C. 255 and 37 CFR 1.324 are not a proper method to obtain reconsideration of a patent term adjustment determination indicated in a notice of allowance if applicant fails to submit a request for reconsideration within the time period specified in 37 CFR §1.705(b) or to obtain reconsideration of a patent term adjustment determination indicated in a patent if a patentee fails to submit a request for reconsideration within the time period specified in 37 CFR §1.705(d). See 69 Fed. Reg. 21704, 21707 (April, 22, 2004).

In view thereof, the petition under 37 CFR 1.183 for waiver of the two-month requirement of 37 CFR 1.705(d) is dismissed.

Accordingly, consideration now turns to the Request for Reconsideration of Patent Term Adjustment under 37 CFR 1.705(d).

**REQUEST FOR RECONSIDERATION OF  
PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705(d)**

Patentees request correction of the patent term adjustment (PTA) indicated in the patent to seven hundred fifty-three (753) days.

On March 11, 2008, the above-identified application matured into U.S. Patent No. 7,342,014 with a revised patent term adjustment of 357 days. The instant request for reconsideration was filed more than ten months after the issuance of the patent, on February 2, 2009.

No error in the printing of the patent has been shown. The patent term adjustment indicated on the patent reflects the Office's determination of patent term adjustment shown in the PAIR system for this application. 37 CFR 1.705(d) provides the sole avenue before the Office for requesting reconsideration of the Office's determination of patent term adjustment indicated in the patent. Moreover, 37 CFR 1.705(d) states that "any request for reconsideration of the patent term adjustment indicated in the patent must be filed within two months of the date the patent issued and must comply with the requirements of paragraphs (b)(1) and (b)(2) of this section." Since the request was not filed within two months of the issue date of the patent, the request is properly **dismissed as untimely filed.**

#### CONCLUSION

It is determined that waiver of the requirement pursuant to 37 CFR 1.183 is not warranted. Accordingly, the request for reconsideration of the patent term adjustment under 37 CFR 1.705(d) filed more than two months after the issue date of the patent is dismissed as untimely filed.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). Patentees submitted \$130.00 towards the \$400.00 Rule 183 fee. Pursuant to patentees' authorization, deposit account no. 15-0030 will be charged the \$270.00 balance due. No additional fees are required.

Telephone inquiries specific to this matter should be directed to Shirene Willis Brantley, Senior Petitions Attorney, at (571) 272-3230.



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